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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,942	12/16/2004	Hubert Baumgart	PAT-00383	2876

26922 7590 03/21/2006

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EXAMINER
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HAILEY, PATRICIA L

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/518,942	<b>Applicant(s)</b> BAUMGART ET AL.	
	<b>Examiner</b> Patricia L. Hailey	<b>Art Unit</b> 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>16 December 2004</u> . | 6) <input type="checkbox"/> Other: _____  |

Applicants' Preliminary Amendment, filed on December 16, 2004, has been made of record and entered. In the amendment, claims 1-17 have been amended to conform to current U. S. Patent practice; no claims have been canceled or added.

Claims 1-17 are pending in this application.

*Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Applicants' Priority Document was filed on December 16, 2004.

*Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. *Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent No. 1 092 758 (Applicants' submitted art).*

The European Patent teaches a curable composition comprising a hydrophobic silica and a hydrophilic silica, wherein the hydrophilic silica exhibits a primary particle diameter of 10 to 30 mμ (millimicrons, also known as nanometers), and a specific

surface area preferably ranging from about 50 to 800 m<sup>2</sup>/g. See paragraphs [0015] and [0074] of the European Patent.

The hydrophobic silica exhibits a primary particle diameter ranging from 5 to 50 nm. See paragraph [0076] of the European Patent.

The above disclosures are considered to read upon **claims 1, 2, and 6-8**.

In the curable composition, when both a hydrophilic silica and a hydrophobic silica are present therein, the silicas are present in hydrophobic silica/hydrophilic silica weight ratios ranging from 1/99 to 99/1. See paragraph [0080] of the European Patent (considered to read upon **claims 3-5**).

The curable composition is suitable for use as a coating material, especially a paint. Further, application of the curable composition results in the formation of a desirable coating film (i.e., excellent in properties such as film strength, film hardness, surface smoothness, antifouling), when applied to surfaces such as an electrical part, a ship shell plate, an underwater structure, etc. See paragraphs [0011]-[0012] of the European Patent (this disclosure is considered to read upon **claims 15-17**).

The silicas are present in the curable composition in amounts ranging from 1 to 100 parts by weight (pbw), based on an organopolysiloxane component. See paragraph [0078] of the European Patent. While this disclosure makes reference to either silica, the reference discloses a composition containing both silicas (paragraph [0015], as discussed above); from these teachings, one skilled in the art would deduce that a composition

containing both a hydrophobic silica and a hydrophilic silica would do so in, at the very least, equal amounts (i.e., 50 pbw of each silica).

This disclosure is considered to read upon **claims 11-13**.

The curable composition is produced by heating the organopolysiloxane component together with the silicas, along with agitation and mixing of these components. See paragraphs [0103]-[0105] of the European Patent (considered to read upon **claim 14**).

With respect to **claims 9 and 10**, the European Patent at paragraphs [0074]-[0076] discuss exemplary hydrophilic silicas, such as wet process silica and dry process silica, as well as the obtention of hydrophobic silica via treatment of the hydrophilic silica (considered to read upon the limitation "surface modification"). Further, both hydrophobic silicas and hydrophilic silicas are known in the art as pyrogenic silicas, as exemplified by U. S. Patent No. 3,580,519 (col. 1, lines 74 to col. 2, line 4, and col. 2, lines 31-34), which is relied upon only to provide technological background.

In view of these teachings, the European Patent anticipates claims 1-17.

### *Conclusion*

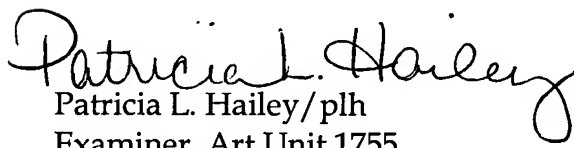
4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Hailey whose telephone number is (571) 272-1369. The examiner can normally be reached on Mondays-Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 1700 Receptionist, whose telephone number is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Patricia L. Hailey/plh  
Examiner, Art Unit 1755  
March 20, 2006

  
J.A. LORENGO  
SUPERVISOR, PATENT EXAMINER